

REMARKS

Reconsideration of the above-identified application, as amended, is respectfully requested.

In the Office Action of April 7, 2005, the Examiner rejected Claims 1-13, 18, 19-30, 35, 36-47 and 52-55 under 35 U.S.C. §103(a), as being allegedly unpatentable over Sun et al. (U.S. Patent Publication No. 2002/0143994) (hereinafter "Sun") in view of Becker et al. (U.S. Patent Publication No. 2002/0130904) (hereinafter "Becker"). The Examiner further rejected Claims 14-17, 31-34 and 48-51 under 35 U.S.C. §103(a), as being allegedly unpatentable over Sun and Becker as applied to Claim 1, and further in view of Lloyd et al. (U.S. Patent No. 6,779,178) (hereinafter "Lloyd").

With respect to the rejection of Claims 1-13, 18, 19-30, 35, 36-47 and 52-55 under 35 U.S.C. §103(a), as being allegedly unpatentable over Sun in view of Becker, applicants respectfully disagree in view of remarks and clarifying amendments herein.

The present invention as set forth in amended Claims 1, 19, 36 and 53 is directed to a method for providing "ink annotations". To clarify the invention, Claims 1 (and Claims 19 and 36) are being amended to set forth a method, system and computer program product for annotating messages for communication within an interconnected network of computers. The method comprises steps of: establishing a connection to a messaging service adapted to provide users with a recording comprising one or more messages for viewing; and, inputting handwritten stroke information message objects

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into a message anywhere within the recording to thereby annotate said message, said messaging service distributing said annotated message in said recording to other users.

Respectfully, no new matter is being entered by the amendments to Claims 1 (and 19, 36 and 53). For example, the recited "recording" refers to the representation or "view" of a message record (e.g., Instant Message record maintained by the IM messaging service that keeps a record of all the current messages including the ink annotation on these records) including all messages exchanged in a messaging session (see specification, page 7, lines 20-35). Additionally, clearly described in the specification and fully supported therein, is the ability to provide ink annotations "anywhere" within the recording. This support is found, e.g., in the paragraph bridging pages 13 and 14 in the specification as filed in support of Figures 5A-5C in describing how a spatial annotation may be input to a selected (e.g., earlier) message within the recording.

The independent Claims 1, 19, 36 and 53 and certain claims dependent thereon have been amended to remove reference to a "current" message. A message to be annotated may be "any" message within the recording, not necessarily the last message in the user's field of view. Further, changes are made to certain dependent Claims to conform to the added recitation of a recording as now set forth in the amended independent claims. The key is that the invention provides a time and space association between the ink annotation stroke and the existing records.

The applied combination of Sun and Becker do not teach the present ink "annotation" methodology of the invention. Sun discloses an ink instant messaging system, while Becker discloses a GUI for easy management of multiple instant message sessions. Lloyd does not help in this regard as Lloyd appears to disclose a method of adding a personal

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ink written signature at the end of an email message. Each of these prior art systems treat "ink" as another independent media type of instant message. The major difference of the present invention is that the "ink data" is treated as a dependent annotation tool to associate (in space and time) with existing message records. None of these references, whether alone or in combination, teach or suggest this concept.

Having demonstrated the patentability of Claims 1 and 19, related dependent claims 2-18 and 20-35 are clearly patentable as being dependent thereupon.

For instance, with specific regard to related Claims 11 and 12, these claims are clearly patentable over the cited combination of references. Claim 11's recitation of entering text into a text input field wherein the text is associated with the message objects for transmission to the messaging service and, Claim 12's recitation of entering handwritten stroke information into a handwritten stroke input field wherein the handwritten stroke information is associated with the message objects for transmission is neither taught nor suggested by the combination of prior art references. For instance, the GUI depicted in the present specification of Figure 6 provides the space correlation where the text (claim 11) and ink (claim 12) are correlated with the existed records which is neither taught nor suggested by the combination of prior art references.

With specific regard to Claims 13, 14, 15, 16, 17 it is a feature of the present invention to maintain the complete history of messaging with annotations which is required to provide ability to display the "ink annotation on all the existed records" according to the invention. At best, the combination of references in the prior art would suggest only keeping the partial history that is filled up to its display windows. Moreover, these prior art references only display the URL in the status bar as regular HTTP browser usage. These URLs exist

only in the server, and are not embedded in the individual object (e.g., web page). To the contrary, the present invention makes use of Hyperlink and back links techniques (shown in Figure 5A-5D) embedded inside the instant message object for such navigation purpose across complete existed instant message records. Moreover, the hyperlinks are used for annotation alerting to user. These hyperlinks are embedded inside and are part of the instant message object (See Fig. 5B).

With specific regard to Claim 18, the invention makes use of content based searching technique, not only in text space, but also in the image based. These techniques work better when the input for the searching is based on a characteristic pattern, for example. For the entire instant message record, while a globally characteristic pattern might not exist, some localize patterns are more possible. Human perception is best known to visualize such localize pattern. Consequently, the current invention discloses how to make use of the ink annotation for selecting the area for searching which is neither taught nor suggested in the applied prior art.

The changes made herein with respect to Claims 1-18 are additionally applicable to Claims 19-55.

Respectfully, applicants do not see how this combination would teach the present invention, and the Examiner is respectfully requested to withdraw the rejections of Claims 1, 19, 36 and 53 under 35 U.S.C. §103(a). Accordingly, the Examiner is respectfully requested to withdraw the rejection of all claims dependent upon amended independent Claims 1, 19, 36 and 53.

In view of the foregoing remarks herein, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this

application be allowed and a Notice of Allowance be issued. If the Examiner believes that a telephone conference with the Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned, Applicants' attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,



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